

REMARKS

The Office Action of October 12, 2007 has been reviewed and the comments of the Examiner have been considered. Claim 6 stands objected to for an informality, and claim 7 stands rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 7 have been amended, and applicants again propose to withdraw the restriction requirement with respect to claims 36-47. Claims 1, 135 and 137 have been cancelled and, according to the Examiner, claims 2, 3, 5, 8-10, 12-26, 36-47, 52-54, and 58-134 stand withdrawn. Applicants thank the Examiner for the rejoinder of claims 4, 6, 7 and 11 and the indication of allowable subject matter with respect to claims 4, 6, 7, 11, 27-35, 48-51, 55-57, 136 and 138-153.

Claim 7 stands rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. *See* Detailed Action at 4, para. 7. More specifically, the Examiner asserts that claim 7 is indefinite because the claimed "member" never contacts "at least one of the locator and metallic disc annulus" in FIGS. 4A-4E, contrary to the recited contact between the member and at least one of the locator and metallic disc annulus in claim 7. *See id.* Applicants disagree, because to the extent the Examiner is basing the rejection upon the figures failure to expressly show a claimed feature, applicants contend that such reasoning cannot serve as a basis for rendering a claim indefinite under 35 U.S.C. 112, second paragraph.

There are two requirements under 35 U.S.C. 112, second paragraph: i) the claims must set forth the subject matter that applicants regard as their invention; and ii) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. MPEP 2171 at 2100-216. To the extent the Examiner asserts that claim 7 fails to satisfy the first requirement, a rejection based upon such an assertion, "is appropriate only where [the] applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims." MPEP 2172 at 2100-217 (emphasis added). "[T]he invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention." *Id.*

(citation omitted). Moreover, according to MPEP 2172, “the content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention.” *Id.* Section 2172 goes on further to state that “agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” *Id.* (emphasis added). Because the Examiner has not identified evidence outside the application that the invention is something other than claimed, a rejection under 35 U.S.C. 112, second paragraph, based upon an applicants’ alleged failure to set forth the subject matter that they regard as their invention, cannot stand.

With regard to the second requirement, under 35 U.S.C. 112, second paragraph, the essential inquiry “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” MPEP 2173.02 at 2100-218. According to the MPEP, definiteness of claim language must be analyzed, not in a vacuum, but in light of: i) the content of the particular application disclosure; ii) the teachings of the prior art; and iii) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.* at 2100-218. “In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.” *Id.*

The Examiner does not allege that one of ordinary skill would not be apprised of the scope of claim 7, but rather asserts that a claimed feature is not expressly shown in the figures. “A claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible.” *Id.* at 2100-219 (citing *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004) in which it was held that that a disputed claim term not defined or used in the specification was discernible and hence not indefinite because “the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence”). Applicants submit that absence of a figure expressly showing the claimed “member” contacting “at least one of the locator or metallic disc annulus” does not render claim

7 indefinite where the meaning of the feature is discernible from the application originally-filed as a whole.

Notwithstanding the above, to further particularly point out and further distinctly claim the subject matter which applicants regard as their invention, applicants have amended claim 7 so as to recite “the member contacting at least one of the locator, metallie disc annulus, and support member to translate the face of the annulus to a side of the longitudinal axis.” (emphasis added) Withdrawal of the rejection of claim 7 is respectfully requested.

Claim 6 was objected to for repeating the phrase “the second means.” Claim 6 has been amended to correct the identified informality, and withdrawal of the claim objection is respectfully requested.

Finally, each of the claims listed above is now believed to include the appropriate status identifiers. In particular, claims 2, 3, 5, 8-10, 12-26, 52-54, and 58-134 are indicated as withdrawn in view of the Examiner’s remarks at page 3, paragraph number 4. However, applicants submit that claims 36-47 should be rejoined and allowed because each of claims 36-47 depend directly or indirectly from allowed claim 35. MPEP 821.04(a) at 800-65 (“any restriction requirement between the elected invention and any nonelected invention that depends from or otherwise requires all the features of an allowable claim should be withdrawn”). Rejoinder of claim 36-47 is respectfully requested.

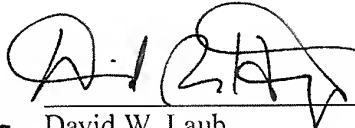
CONCLUSION

In view of the foregoing amendments and remarks, applicants respectfully request reconsideration of this application and the prompt allowance of at least claims 4, 6, 7, 11, 27-51, 55-57, 136 and 138-153. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the undersigned to expedite prosecution of the application.

The Commissioner is hereby authorized by this paper to charge any fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-3840.

Respectfully submitted,

Date: January 14, 2008


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